

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of October 07, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

As an initial matter, the Applicants wish to thank the Examiner for his time in regard to this application and for taking the time to explain details regarding the present Office Action during telephone communications on November 8<sup>th</sup> and November 10<sup>th</sup>. This response has been written in accordance with the agreements reached during the telephone conversations.

In paragraph 5 of the Office Action, claims 1-11 have been rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. In response, Applicants have amended claim 1 to clarify that the method is a computerized method and is therefore tied to a technological art. Accordingly, withdrawal of the 35 U.S.C. § 101 rejection regarding claims 1-11 is respectfully requested.

In paragraphs 6-7, claims 1-29 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Information Update on Neural Tree Networks, (IEEE 0-7803-6725-1/01) by Stefania Gentili (Gentili). The Examiner had rejected the affidavits that the Applicants previously submitted under 37 C.F.R. § 1.131. During the telephone communication of November 10<sup>th</sup>, the Applicants expounded upon the conception and diligence aspects relevant to the previously presented affidavits in the context of the present invention, the Examiner indicated that the affidavits would be accepted once the verbally-expressed aspects were presented to him in writing, which the Applicants shall now proceed to do.

Applicants note that they are permitted to show conception prior to the date of the reference coupled with due diligence from prior to the reference date to the filing date of

the application (constructive reduction to practice coupled with diligence under MPEP 714.07 (III)(C) ). Further, case law and the MPEP sections permit companies like IBM, to exercise diligence by showing reasonable business practices designed to obtain patentable rights on employee inventions. Such practices can include reviewing conceived inventions, selecting inventions to patent, soliciting counsel to prepare a patent, and permitting the outside counsel to prepare the patent in cooperation with inventor comments.

Consequently, and in accordance with MPEP 714.07 (III)(C), Applicants have resubmitted Declarations under 37 C.F.R. § 1.131 supporting the removal of Gentili as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0029 entitled "A Fast Way of Tuning Decision Tree Models." The Disclosure and Declarations demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as April 13, 2000, which predates the effective date of Gentili (October 10, 2001).

The Disclosure is a completion of an International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by the IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since April 13, 2000.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art.

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The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the USPTO, the inventors review the application to insure that the claims and material contained therein are fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Gentili until January 22, 2002, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Gentili and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Gentili should be withdrawn as a reference for purposes of 35 U.S.C. § 102. Consequently, the rejections to claims 1-29 under 35 U.S.C. § 102(a) based upon Gentili should be withdrawn, which action is respectfully requested.

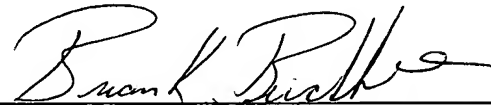
The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

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Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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